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Accenture/Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue Washington, DC 20001-4413			EXAMINER MCPHILLIP, ADRIAN J	
			ART UNIT 3623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

betty.finley@finnegan.com  
dianna.williams@finnegan.com  
catherine.vanhouten@finnegan.com

### Office Action Summary

**Application No.**

10/767,661

**Applicant(s)**

SVILAR ET AL.

**Examiner**

Adrian J. McPhillip

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,7,9-11,13,16,19,21-23 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9-11,13,16,19,21-23 and 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20100615
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 11, 2010 has been entered.
2. This Non-Final Office Action is in response to Applicant's request for continued examination filed on March 11, 2010. Claims 1, 7, 13 and 19 have been amended. Claims 2-3, 5-6, 8, 12, 14-15, 17-18, 20 and 24 have been cancelled. Claims 25-41 have been newly added. Currently claims 1, 4, 7, 9-11, 13, 16, 19, 21-23 and 25-41 are pending in this application.

### **Response to Amendment**

3. Applicant's amendments to claims 1, 7, 13 and 19 are hereby acknowledged. However, it is noted that the amendments made to the claims, as well as the limitations being relied upon to render Applicant's remaining claims statutory, do not have support in the specification. Specifically: using a computer processor to execute the claimed method steps, and incorporating a processor, display device, user interface and memory storing data and instructions into the Applicant's claimed system are features/embodiments which do not have support in the filed Written Description. As such, the 101 rejections that would be present for all of the Applicant's pending claims, have been provisionally withdrawn pending the Applicant's ability to point out

where in the specification the amended features are supported. Failure to do so would result in the reinstatement of the aforementioned 101 rejections. In this action, Applicant has attempted to point out where the features in question are supported by written description but the Examiner has found these arguments unpersuasive for the reasons that follow. Accordingly, the Examiner maintains the previously issued rejections under U.S.C. 112, first paragraph.

#### **Response to Arguments**

4. Applicant's arguments filed on January 22, 2010 have been fully considered but are not persuasive.
5. Applicant argues first that the Examiner's designation of the previous Office Action as final was incorrect. Applicant's primary evidence for this allegation is that the Examiner's presentation of the Gatto reference to support the previously officially noticed facts is evidence that the fact itself was not capable of instant and questionable demonstration. This is incorrect as the only reason that the Examiner provided this reference was to indeed prove that the fact was capable of instant and questionable demonstration. By providing the reference the Examiner has actually proven that the fact was capable of instant and unquestionable demonstration, which in fact validates the original taking of Official Notice.

It is further noted that the use of a reference to support an Officially Noticed fact does not constitute a change in the grounds of rejection. The claims are still rejected in view of the cited prior art and further in view of Examiner's official notice. The Examiner has merely provided evidence to support the fact(s) in question in response to the Applicant's assertion that the facts were not of capable of instant and unquestionable demonstration and in an effort to efficiently

advance prosecution of the case. Applicant is respectfully directed to section 2144.03 (D) of the MPEP that states, "If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final." Accordingly, this argument is unpersuasive.

6. Applicant goes on to argue that the rejections of the claims for lack of written disclosure should be withdrawn. Despite not mentioning a processor, computer or memory anywhere in the specification Applicant is asserting that the specification discloses embodiments of the invention including:

- a computer implemented method that uses a computer processor to implement the claimed steps,
- a computer implemented system comprising: a processor, at least one memory storing data and instructions, a display device, a user interface, and distinct modules embodied on a computer readable medium,
- a computer program product comprising a computer readable medium having computer-readable code embodied therein, the code implementing the claimed computer implemented method.

Applicant asserts that since the Abstract discloses a customized software tool and Figs 2-3 show a screenshot of an input screen, and since the recited "processor," "display device," "user interface," "distinct software modules," and "memory" are known components of systems that employ "a customized software tool", that the written disclosure provides support for the

forementioned embodiments. The Examiner respectfully disagrees and notes that the standard for determining whether the written disclosure amply supports the claims is that a person of ordinary skill in the art would have understood, at the time the application was filed, that the description **requires** that limitation. Hyatt v. Boone 47 USPQ2d 1128. What would have been obvious to one of ordinary skill in the art **is not the test**. Possession of the invention must be shown by the written description and “does not extend to subject matter not disclosed but that would be obvious over what is expressly disclosed.” Lockwood v. American Airlines Inc. 41 USPQ 1961. Applicant’s rationale that, “it is well known that software tools require processors, distinct software modules, display devices, user interfaces and memory components,” may well be true, however the claim is directed to the software tool itself and not to the myriad of potential configurations that could be utilized to implement the tool. Merely claiming the software tool itself, does not afford the Applicant protection over each and every possible permutation of computer configurations that are known to implement customized software tools, and the same holds true for disclosing such a software tool in the written description. The fact that these are known components merely means that it would be obvious to implement a customized software tool utilizing such components. It does not mean that they are **required** components as is necessary for establishing possession of the invention. Indeed, a customized software tool could be implemented utilizing a communication bus, or a network server, or any number of other known/obvious components for systems that employ such tools. These components however, are not required and are therefore not implicitly disclosed simply by disclosing a customized software tool. For this reason the Examiner maintains that the Applicant’s written disclosure does not support the features being relied upon to render the claimed invention statutory, and

accordingly maintain the rejection under 35 U.S.C. 112, first paragraph. It is noted that every embodiment claimed by the Applicant, including those newly added and comprising computer readable media, is subject to the above interpretation by the Examiner and as such all of the pending claims have been rejected for at least this reason.

7. Applicant argues the rejections under 35 USC 101 stating that claim 13 now recites elements that necessarily constitute a system or apparatus. The Examiner agrees and notes that while the limitations do render the Applicant's claims statutory, these limitations are not supported by the written disclosure. Accordingly the 35 USC 101 rejections have been withdrawn and 35 USC 112, first paragraph rejections have been issued. If the elements that make the Applicant's system statutory: processor, display device etc. are removed, Examiner reserves the right to reissue rejections under 35 USC 101 as appropriate.

8. Applicant also argues that the previously issued 103 rejections should be withdrawn because the cited prior art fails to teach a generating module that displays both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand; and (ii) the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments, as recited in claim 13. The Examiner respectfully disagrees since Schroeder discloses generating forecasted and actual consumer demand and shipment data (see ¶ [0073] wherein forecasted demand and shipment estimates are generated and ¶ [0074]-[0078] wherein actual demand and shipping practices are recorded and analyzed. This demand includes volume data such as actual volume of units sold and predicted volume of units to be sold, and a display device for displaying this data (See claim 43). So Schroeder does indeed disclose the display of both

demand and shipping parameters in terms of forecasted and actual values. Schroeder does not explicitly disclose the display unit generating displays including a first percent error between the forecasted consumer demand and the actual consumer demand a second percent error between the forecasted shipments and the actual shipments. Examiner's Official Notice, supported by Gatto, teaches that it was well known to display percent errors between actual and forecasted data and it would have been obvious for the display device in Schroeder to further display this type of percent error data, or indeed any of the other data being generated/analyzed by Schroeder, because the mere display of data is simply the application of a known technique, displaying data, to a particular data set. Gatto illustrates that the specific display technique comprising the display of percent errors, was well within the capabilities of those of ordinary skill at the time of the invention, therefore the Examiner maintains that Applicant's claimed invention is obvious in view of the applied prior art.

9. Applicant's remaining arguments are directed to features which the Applicant has newly added via amendment, specifically: using econometric modeling to quantify the relative effect of the at least two marketing elements. Therefore this is now the Examiner's first opportunity to consider these limitations in view of the prior art and as such any arguments regarding these limitations would be inappropriate since they have not yet been examined. A full rejection of these limitations in view of the prior art will be presented later in this Office Action.

### **Claim Rejections - 35 USC § 112**

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it



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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 4, 7, 9-11, 13, 16, 19, 21-23 and 25-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner has been unable to discern support for:

- using a computer processor to execute the method steps recited in claims 1, 4, 7, 9-11 and 26-32;
- the system of claims 13, 16, 19, 21-23 and 33-39 comprising a processor; at least one memory storing data and instructions; a display device; a user interface; and distinct software modules embodied on a computer readable medium.
- the method of claims 25 and 40-41 embodied on a computer readable medium and program product.

The lack of support for these features raises doubt as to the possession of the claimed invention, specifically in terms of the aforementioned embodiments, at the time of filing, and it is respectfully requested that Applicant specifically point out where these features are supported by the specification.

#### **Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1, 4, 7, 13, 16, 19, 25-29, 33-36 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US 2003/0130883) – hereinafter Schroeder, in view of Examiner's Official Notice as supported by Gatto (US 20030065601 A1).

15. Regarding **claim 1 and 13**, Schroeder discloses a computer-implemented method and system for using econometric techniques to quantify marketing drivers and forecast consumer demand and shipments, by using comprising:

- providing at least one marketing plan, wherein the at least one marketing plan comprises at least one marketing element (see paragraphs 57-58 and fig 1 wherein proposed promotions/marketing plans are entered into the modeling system);
- using econometric modeling to quantify the effect of the at least one marketing element on shipments (see paragraph 50 wherein the predicted effects of the promotion in question are determined and include an analysis of expected ship quantities. Furthermore paragraph 39 discloses using regression as a method of analyzing the data in question);

- forecasting consumer demand and shipments in response to the at least one marketing plan and results of the econometric modeling (see paragraph 73 wherein the business planner builds shipment estimates and predicts supply chain demand related to the implementation of a particular promotion);
- executing a what-if scenario by enabling a user to make a change in planned spending on the at least one marketing element and using econometric modeling to quantify the effect of the change in planned spending on consumer demand and shipments (see paragraph 29 where planned spending regarding promotional activities are entered into the system. Paragraphs 59-68 then disclose a lift model that details the effects/lift of various promotions, which includes calculating sales and profit figures based on consumer demand and shipping information. Users may then tweak various aspects of the promotion in order to forecast and compare the effects of the different promotions being considered.);
- modifying the at least one marketing plan based on the results of the what-if scenario to generate a modified marketing plan (see paragraph 59 wherein if the predicted results are in alignment, then the promotion may proceed to completion. If the predicted results are not in alignment, then a decision is made whether to modify the promotion plans or operation plans);
- executing the modified marketing plan and capturing actual consumer demand and shipment data (see paragraph 59 wherein the modified plan is implemented and paragraph 102 wherein an embodiment of the invention captures actual demand and

shipment data. Additionally claim 35 captures shipping volume to market data and uses it to estimate sales); and

- displaying predictions pertaining to the planned promotion (see claim 43) and utilizing actual sales data to repeatedly refine the prediction model by comparing predicted data with actual data to maximize the model's utility and minimize future errors (see paragraph 78).

Schroeder does not explicitly disclose displaying both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand; and (ii) the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments.

The examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, to calculate and display percent errors between forecasted data and actual data when evaluating the predictive capacity of a particular model. Schroeder in fact discloses the comparison of forecasted and actual data but does not explicitly calculate percentages between the two. It was however, well known at the time of the invention to calculate the percentage difference between actual and forecasted data, for example Gatto (US 20030065601 A1) discloses a security analyst performance tracking and management system where one embodiment comprises a graphical display wherein the vertical axis may display a measure of the average percent error, both positive and negative, of the estimate for each analyst displayed as compared to actual earnings (see at least ¶ [0110]-[0111]).

Following KSR, the Supreme Court issued several rationales for supporting a conclusion that a claim would have been obvious. If a particular known technique was recognized as part of

the ordinary capabilities of one skilled in the art, and one of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) and the results would have been predictable to one of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

Applicant is applying a known technique, in this case calculating and displaying percent errors between forecasted data and actual data, to a known device, in this case to forecasted and actual consumer demand as well as forecasted and actual shipments, both of which are known elements disclosed by Schroeder, and is generating a predictable result. It would have been obvious, to one of ordinary skill in the art, that the result of applying the aforementioned technique would be a method for generating a predictive model that displayed the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand as well as the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments. Therefore since the Applicant is claiming the application of a known technique to a known device to yield a predictable result, the claim is deemed obvious in view of the prior art.

16. Regarding **claims 4 and 16**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments further comprising calculating a lift parameter of the at least one marketing element (see fig 1 and 2 wherein a lift model calculates the predicted lift that should result from a particular promotion and also paragraph 58).

17. Regarding **claims 7 and 19**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments wherein the at

least one marketing plan comprises at least two of the following marketing elements: promotions, advertising, points of distribution and product changes (see figs 1-2 and paragraphs 18-28 wherein various marketing elements are being analyzed.).

18. Claims 9-11, 21-23, 30-32 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder (US 20030130883 A1) in view of Examiner's Official Notice as supported by Gatto (US 20030065601 A1), and further in view of Cox et al. (US 20020143604 A1) – hereinafter Cox.

19. Regarding **claims 9-11, and 21-23**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments but fails to explicitly teach tracking the reasons for the forecast errors along with the forecast errors themselves.

Cox, however, discloses tracking the accuracy of a predictive model to assess its effectiveness as well as refining model assumptions (see paragraph 128), which are the reasons for the solution that the predictive model comes to. Therefore Cox effectively discloses tracking the errors, in the form of the differences between the predicted and actual values, as well as tracking and eventually refining the reasons for the errors, in the form of the assumptions used by the model to arrive at its predictions.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the method of Schroeder to include tracking the reasons for the forecast errors along with the forecast errors themselves in order to increase the accuracy of future predictions and enhance the effectiveness of the overall model. Since both references are interested in accurately

forecasting demand and since the modification could have been performed readily and easily by one of ordinary skill in the art, with neither undue experimentation nor risk of unexpected results, a rejection under 35 U.S.C 103(a) is appropriate.

20. Applicant's newly added claims 25-41 substantially repeat the limitations recited in claims 1, 4, 7, 9-11, 13, 16, 19, 21-23. The only limitation differentiating claims 25 and 40-41 over the prior art applied to claims 1, 4, 7, 9-11, 13, 16, 19 and 21-23 is that the claims are directed to a computer readable medium comprising coded instructions which when executed perform the method steps recited in claims 1, 4, 7, 9-11, 13, 16, 19 and 21-23. This limitation is insufficient to patentably distinguish claims 25 and 40-41 over the prior art applied to claims 1, 4, 7, 9-11, 13, 16, 19 and 21-23 because embodying a method on a computer readable medium merely comprises the automation of a known process to replace an activity which accomplished the same result. The courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Therefore this limitation fails to patentably distinguish claims 25 and 40-41 over the applied prior art, since it would have been obvious to automate a known process by embodying instructions for performing the process on a computer readable medium.

The remaining limitations of claims 25-41 substantially repeat the limitations recited earlier in claims 1, 4, 7, 9-11, 13, 16, 19, 21-23 and are rejected for the reasons set forth with respect to the corresponding rejections of the limitations in question.

**Conclusion**

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian J. McPhillip whose telephone number is (571)270-5399. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. M./  
Examiner, Art Unit 3623

12/10/2010

/Beth V. Boswell/  
Supervisory Patent Examiner, Art Unit 3623